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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/440,521	05/16/2003	Jeffrey Brady	107920-61596	7793

26345 7590 09/25/2009

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EXAMINER	
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ART UNIT	PAPER NUMBER
3623	

NOTIFICATION DATE	DELIVERY MODE
09/25/2009	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY BRADY, KEVIN MCMURTRY,
and GREG MILLER

Appeal 2009-004339
Application 10/440,521
Technology Center 3600

Decided: September 23, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Jeffrey Brady, Kevin McMurtry, and Greg Miller (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-6, 53-56, and 61, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION[1]

We REVERSE.

THE INVENTION

The Appellants invented a system and method for generating and planning events, meetings, or related series of meetings (Specification 1:9-11).

An understanding of the invention can be derived from a reading of exemplary claim 61, which is reproduced below [bracketed matter and some paragraphs added].

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[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed January 30, 2008) and Reply Brief ("Reply Br.," filed July 15, 2008), and the Examiner's Answer ("Ans.," mailed May 16, 2008), and Final Rejection ("Final Rej.," mailed May 29, 2007).

61. An apparatus for planning at least one assigned-time event correspondent to a request of a non-attendee meeting requester, comprising:

[1] a database storing a plurality of event parameter sets including at least recruiting, venue and speaker meeting parameters and an assigned time associated with the at least one assigned-time event plan, wherein at least some event parameters of the event parameter sets have associated business rules restricting planner selection of others of the event parameters of the event parameter sets in combination with the business rule associated event parameters;

[2] an event logistics module presenting ones of the event parameters for selection by a planner distinct from the non-attendee meeting requestor based on a request from the nonattendee meeting requestor, wherein the presentation of the event parameters from each of the plurality of event parameter sets in the database by the logistics module to the planner is restricted by:

[a] planner selection of at least one other presented event parameter from the plurality of event parameter sets in the database; and

[b] at least one of the business rules responsively to planner selection of a business rule associated event parameter from the plurality of event parameter sets in the database; and

[3] a reporting module, wherein information associated with the assigned-time event plan, in accordance with said assigned time and at least one selected event parameter, is provided to the non-attendee meeting requestor.

THE REJECTIONS

The Examiner relies upon the following prior art:

Bingham et al.	US 6,324,517 B1	Nov. 27, 2001

Claims 1-6, 53-56, and 61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bingham.

ARGUMENTS

Claims 1-6, 53-56, and 61 rejected under 35 U.S.C. §103(a) as being unpatentable over Bingham

The Appellants argue these claims as a group.

Accordingly, we select claim 61 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Examiner found that Bingham described all of the limitations of claim 61, except Bingham fails to describe that the meeting requester is distinct from a meeting planner (Ans. 3-9). The Examiner found that a job title or job function of an individual is merely non-functional descriptive material and therefore is not given patentable weight (Ans. 7). The Examiner further took Official Notice of the fact that it is old and well-known in the art for an individual or company to request help from a third-party to conduct the details of planning an event (Ans. 7-8). The Examiner found that a person with ordinary skill in the art would have recognized that benefit of standardizing practice by outsourcing planning tasks to a third-party event planner (Ans. 8). The Examiner further found that a person with

ordinary skill in the art would have found it obvious to modify Bingham with this old and well-known feature (Ans. 8).

The Appellants contend that (1) Bingham fails to describe that the presentation of at least one event parameter to an event planner is restricted by the selection of another event parameter, as required by limitation [2a] (App. Br. 13 and 16-17 and Reply Br. 4-5), (2) Bingham fails to describe that the presentation of at least one event parameter to an event planner is restricted by at least one business rule responsively to the selection of an event parameter associated to the business rule in addition to the selection of at least one other event parameter presented, as required by limitation [2b] (App. Br. 13 and 18-21 and Reply Br. 4-5), (3) the Examiner erred in rejecting claims 1 and 53 for the same reasons argued *supra* (App. Br. 21-22 and Reply Br. 5-8), and (4) there is no motivation or reason to modify Bingham absent impermissible hindsight, as per claim 53 (App. Br. 23-24 and Reply Br. 8-11).

ISSUES

The pertinent issue to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claim 1-6, 53-56, and 61 under 35 U.S.C. § 103(a) as unpatentable over Bingham. The pertinent issue turns on whether Bingham describes restricting the selection or presentation of an event parameter based on the selection of another event parameter or a business rule associated with a selected parameter.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Appellants' Disclosure

01. The planning system includes a set of specific instructions that are applicable to particular events or event type (Specification 63:1-2). These instructions, or business rules, can be accepted or rejected by the user of the system (Specification 63:13-16).

Facts Related to the Prior Art

Bingham

02. Bingham is directed to a method and system for selecting facilities for holding meetings, conferences, conventions, trade shows, special events, and other group-related events (Bingham 1:23-27).

03. The method includes the steps of receiving a request for a meeting facility where the request defines the minimum requirements for the facility, calculating an all-inclusive cost for the facility, ranking a list of facilities based on the all-inclusive cost, and transmitting a list of a subset of the facilities to a user (Bingham 2:59-67).

04. A user can further request the presentation of a list of amenities that the user can further narrow the subset of available facilities (Bingham 9:56-62).

05. The list of facilities can be sorted based on various criteria, such as cost, location, amenities, and quality (Bingham 10:41-56).

Facts Related To The Level Of Skill In The Art

06. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of event planning and scheduling. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'") (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

07. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1363-64 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d

1364, 1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision. "Where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure" so as to give one of ordinary skill in the art notice of the change. *See Intellicall, Inc., v. Phonometrics, Inc.,* 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed.Cir.1992).)

Obviousness

A claimed invention is unpatentable if, "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 399 and 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of

the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." *Graham,* 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416.

ANALYSIS

Claims 1-6, 53-56, and 61 rejected under 35 U.S.C. §103(a) as being unpatentable over Bingham

The Appellants first contend that (1) Bingham fails to describe that the presentation of at least one event parameter to an event planner is restricted by the selection of another event parameter, as required by limitation [2a] (App. Br. 13 and 16-17 and Reply Br. 4-5) and (2) Bingham fails to describe that the presentation of at least one event parameter to an event planner is restricted by at least one business rule responsively to the selection of an event parameter associated to the business rule in addition to the selection of at least one other event parameter presented, as required by limitation [2b] (App. Br. 13 and 18-21 and Reply Br. 4-5).

We agree with the Appellants. The Appellants specifically contend that the Examiner has misconstrued the term business rule (App. Br. 19) and as such we must determine whether the construction of this term is proper.

First we look to the claims for the context of the term and any limitations imposed by it. Limitation [1] requires that business rules are associated with event parameters and the business rules restrict the selection of other parameters. Limitation [2] further requires that the event parameters

presented to a user for selection are restricted by the selection of another event parameter and a business rule associated with a selected event parameter. That is, the available event parameters presented to a user are determined based the user's selection of another event parameter and whether that selected parameter has a business rule associated to it.

Next we look to the Specification for any definition of the term and its usage to also give insight to the context of its use. The Specification is silent as to a specific definition for business rule. The Specification uses the context of a business rule as a set of specific instructions applied to the planning of particular events of event types (FF 01).

The Examiner and the Appellants agree that the plain meaning of the term business rule is a statement that defines some aspect of business or how the business operates (App. Br. 13 and Ans. 11). The Examiner applies this definition to claim 61 and constructs a business rule to require nothing more than the mere input of meeting preferences and minimum requirements (Ans. 11). The Examiner found that Bingham describes the input and selection of a meeting or event parameters and therefore describes restricting the presentation of a parameter based on a business rule associated to a selected parameter (Ans. 11).

However this would instead be a rule about the process of managing a database rather than a rule restricting planner selection of others of the event parameters of the event parameter sets in combination with the business rule associated event parameters. It might allow entry of the rules as claimed, but would not itself be such a rule. Also, this construction renders a business rule to be synonymous with a set of meeting requirements or the definition of a single meeting. This is not compatible or consistent with the

Specification. The Specification and claims consistently use the term business rule as an expression that governs aspects of a particular *type* of meeting and is more than just a collection of meeting parameters that define a single meeting. The Examiner is not making any distinction between the definition of a single meeting, versus a definition that controls a *type* of meeting. In particular, a business rule governs the process of a specific *type* of meeting being defined and we construe a business rule to be an expression that defines the availability of meeting parameters for a particular *type* of meeting.

Bingham describes a method where a user defines the parameters of a meeting and the system returns a list of facilities and an all-inclusive cost associated with each facility (FF 03). Bingham enables a user to narrow the list of facilities based on required amenity parameters (FF 04) and further allows a user to sort the list based on an event parameter (FF 05). However, Bingham fail to explicitly describe restricting the selection or presentation of event parameters based on other selected parameters or business rules associated those selected parameters. Bingham fails to describe restricting the selection or presentation of a parameter based on an expression that controls the available parameters for a particular type of meeting. Bingham is silent on any feature that describes restricting the selection or presentation of any parameter. As such, Bingham fails to describe limitations [1] and [2] of claim 61.

The Appellants also contend that (3) the Examiner erred in rejecting claims 1 and 53 for the same reasons argued *supra* (App. Br. 21-22 and Reply Br. 5-8). We agree with the Appellants. The Appellants' arguments were found to be sufficient *supra* and are found to be sufficient here for the

same reasons. As such, Bingham fails to describe the limitations of claims 1 and 53.

Although the Appellants further contend that (4) there is no motivation or reason to modify Bingham absent impermissible hindsight, as per claim 53 (App. Br. 23-24 and Reply Br. 8-11), we need not reach this argument since the Appellants' arguments *supra* were found to be dispositive.

CONCLUSIONS OF LAW

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-6, 53-56, and 61 under 35 U.S.C. § 103(a) as unpatentable over Bingham.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-6, 53-56, and 61 under 35 U.S.C. § 103(a) as unpatentable over Bingham is not sustained.

REVERSED

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